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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,516	05/22/2000	Alan Ramaley	13237-2610	2417

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EXAMINER
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CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,516

Applicant(s)

RAMALEY ET AL.

Examiner

Joshua D Campbell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is responsive to communications: Application filed on 05/22/2000.
2. Claims 1-22 are pending in this case. Claims 1, 10, and 18 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Weingarten (teach yourself... Word Perfect 6.1 for Windows, published in 1995).**

5. **Regarding independent claim 1**, the applicant discloses:

- receiving from the author's computer a copy of the electronic document having a first property identifying the location of the electronic document in the memory of the author's computer and indicating that the copy of the electronic document is to be reviewed;
  - Mori et al. discloses a method in which a document is received by an reviewer's computer that is denoted necessary for review based on symbols attached to the document (column 3, line 57-column 4, line 26 of Mori et al.). Along with the document a record is sent which includes the address of the sending station (where the document was created) and the document record (location of document) (column 6, line 63-column 7, line 7 of Mori et al.).
- in response to receiving the copy of the electronic document, opening the copy of the electronic document within an application program and displaying the copy of the electronic document on a display device;
  - Mori et al. discloses a method in which the document is displayed once received by the reviewer (column 4, lines 4-26 of Mori et al.).
- in response to user input, editing the copy of the electronic document to create an edited electronic document; and sending the edited electronic document to the author's computer, said edited electronic document having said first property.
  - Mori et al. discloses a method in which the reviewer amends the document at which point it is retransmitted to the sender based on the

document record (column 4, lines 4-26 and column 6, line 63-column 7, line 7 of Mori et al.).

- in response to detecting the first property with the application program, displaying on the display device a review toolbar comprising selectable control elements corresponding to document review operations
  - o Mori et al. Does not disclose displaying a toolbar comprising review operations to the user once the document is being viewed. However, Weingarten discloses a method in which a toolbar is provided as part of a document-editing program that contains editing operations (Page 44, "The Power Bar" of Weingarten). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of Weingarten in the method of Mori because it would have been more user friendly.

6. **Regarding dependent claim 2**, the applicant discloses:

- a unique identification number identifying the location of the electronic document in the memory.
  - o Mori et al. discloses a method in which a document is sent including a record which incorporates a station address for the sending station at which the document was created (column 6, line 63-column 7, line 7 of Mori et al.).

7. **Regarding dependent claim 3**, the applicant discloses:

- the first property is a custom OLE document property.

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- Mori et al. does not disclose a method in which the first property is an OLE property. However, Weingarten discloses a method in which objects are contained within a document using OLE (Page 277, paragraph 2 of Weingarten). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use OLE to an object such as the document properties in the document because it would have increased the number of programs that could have viewed the document.

8. **Regarding dependent claim 9**, the applicant discloses:

- the review toolbar is continuously displayed until in response to user input the review toolbar is removed from the display device.

- Mori et al. does not disclose showing a toolbar until it is removed.

However, Weingarten discloses a method in which a toolbar is shown until the user chooses to hide it (Page 44, "The Power Bar" of Weingarten).

**Claims 6-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Weingarten (teach yourself... Word Perfect 6.1 for Windows, published in 1995) as applied to claim 1 above, and further in view of Netscape Communications Corporation (Netscape Navigator Gold, Version 3.01 Gold).**

9. **Regarding dependent claim 4**, the applicant discloses:

- the copy was received via electronic mail;

- o Mori et al. discloses a method in which documents are circulated via electronic mail (column 1, lines 19-24 of Mori et al.).
  - the copy of the electronic document further comprises a second property indicating an electronic mail address from which the copy of the electronic document was sent.
    - o Neither Mori et al nor Weingarten discloses a method in which a sender's address would be included. However, Netscape Communications discloses a method in which the sender's electronic mail address is disclosed to the recipient (Page 2, Netscape Communication Corporation). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the methods of Mori et al. and Weingarten with the method of Netscape Communications Corporation because it would have allowed a user to know who sent the electronic mail.
10. **Regarding dependent claim 5**, the applicant discloses:
- second property is a custom OLE document property.
    - o Mori et al. does not disclose a method in which the first property is an OLE property. However, Weingarten discloses a method in which objects are contained within a document using OLE (Page 277, paragraph 2 of Weingarten). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use OLE to an object such as the document properties in the document because it would have increased the number of programs that could have viewed the document.

11. **Regarding dependent claim 6-8**, the applicant discloses:

- the first property is created in response to attaching said electronic document to an electronic mail message.
    - o Neither Mori et al. or Weingarten et al. discloses creating the first property in response to attaching the document to an electronic mail message.
- However, Netscape Communications Corporation discloses a method in which when a file is attached to an email, the original location of that file on the sender's computer is registered (Page 2 of Netscape Communications Corporation). This can be seen by attaching a file to the a new electronic mail created by Netscape Communications Corporation and then viewing said attachments using the "Attachment" button. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Mori et al. and Weingarten in combination with the method of Netscape Communications Corporation because it would have provided recipients with more information about the file they are receiving.
- the first property is created in response to detecting that a selectable control element corresponding to the electronic document has been dragged into an electronic mail message body; and the first property is created in response to detecting that a copy of the electronic document has been pasted into an electronic mail message body.



- It would have been well known in the art at the time the invention was made that "drag and drop" and "copy and paste" are methods of associating files with an application, such as attaching documents to an email.

**Claims 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Novell ("Press Release" published in 1997).**

12. **Regarding independent claim 10**, the applicant discloses:

- sending to a reviewer a copy of the electronic document, said copy having a first property identifying the location of the electronic document in the memory and indicating that review of the copy has been requested,
  - Mori et al. discloses a method in which a document is received by an reviewer's computer that is denoted necessary for review based on symbols attached to the document (column 3, line 57-column 4, line 26 of Mori et al.). Along with the document a record is sent which includes the address of the sending station (where the document was created) and the document record (location of document) (column 6, line 63-column 7, line 7 of Mori et al.).
- receiving from the reviewer an edited electronic, said edited electronic document comprising an edited version of the electronic document, and said edited electronic document having said first property,

- Mori et al. discloses a method in which the reviewer amends the document at which point it is retransmitted to the sender based on the document record (column 4, lines 4-26 and column 6, line 63-column 7, line 7 of Mori et al.).
- based on the first property, retrieving the electronic document from the memory, and automatically merging the edited electronic document into the electronic document.
  - Mori et al. does not disclose a method in which the reviewed and original documents are merged. However, Novell discloses a method in which any changes made to a document copy on an intranet are reflected on the original copy (Page 1, paragraph 2 of Novell).

13. **Regarding independent claim 18**, the claim incorporates substantially similar subject matter as claim 10. Thus, the claim is rejected along the same rationale as claim 10.

**Claims 11-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Novell ("Press Release" published in 1997) as applied to claims 10 and 18 above, and further in view of Weingarten (teach yourself... Word Perfect 6.1 for Windows, published in 1995).**

14. **Regarding dependent claims 11-17**, the claims incorporate substantially similar subject matter as claims 2-8. Thus, the claims are rejected along the same rationale as claims 2-8.

15. **Regarding dependent claims 19-22**, the claims incorporate substantially similar subject matter as claims 2-5. Thus, the claims are rejected along the same rationale as claims 2-5.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent Number 6,070,175, filed August 26, 1997, by Mezei.**

**US Patent Number 5,671,428, issued September 23, 1997, to Muranaga et al.**

**US Patent Number 6,584,466, filed April 7, 1999, by Serbinis et al.**

**US Patent Number 5,835,601, issued November 10, 1998, to Shimbo et al.**

**US Patent Number 4,912,637, issued March 27, 1990, to Sheedy et al.**

**US Patent Number 6,067,551, filed on November 14, 1997, by Brown et al.**

**US Patent Number 5,890,177, issued March 30, 1999, to Moody et al.**


**US Patent Number 5,809,513, issued September 15, 1998, to Okishima.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

jdc  
October 16, 2003



SANJIV SHAH  
PRIMARY EXAMINER